

Application Number 09/930,940
Amendment dated December 15, 2004
Responsive to Office Action mailed September 22, 2004

REMARKS

This amendment is responsive to the Office Action dated September 22, 2004. Applicant has amended claims 72-74, 79, 83-84, 86-87, 89-95, 97, and 105-113. Claim 73 has been cancelled. Claims 72, 74-113 are pending upon entry of this amendment.

Claim Rejection Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 72-113 under 35 U.S.C. 102(e) as being anticipated by Frieden, et al. (US 6,480,100). Applicant respectfully traverses the rejection to the extent such rejection may be considered applicable to the amended claims.

Claim 72 has been amended to recite a method of transferring and using information, comprising creating at least one file containing information from an existing database, wherein the information relates to a plurality of items, reformatting the information in a desired manner to facilitate the use of the information by an RFID tag conversion device, exporting the reformatted information to a database stored on a data storage device, and writing reformatted information related to a selected item of the plurality of items to an RFID tag using the RFID tag conversion device. Claim 105 has been similarly amended. Claims 72 and 105 thus recite that a file containing information from an existing database is created. Claim 105 further recites that the information includes at least one list of a plurality of items. Support for this amended claim language can be found in the specification at page 4, line 30 through page 5, line 5.

Frieden, et al. is directed to an RFID tag formatting method which allows customization of the RFID tag data format and makes that format readily determinable by other users of the tag (see Frieden, et al. at col.2, lines 52-56).

Frieden, et al. fails to disclose each and every feature of the claimed invention, as required by 35 U.S.C. 102(e), and provides no teaching or suggestion that would have suggested the desirability of modification to include such features. For example, Frieden et al. fails to teach or suggest creating at least one file containing information from an existing database, as recited by Applicant's amended claims 72 and 105.

With regard to these elements of claims 72 and 105, as amended, the Office Action states that Frieden, et al. "teaches the information exported to the data storage device comprises at least one list of items to be converted to RFID tagged items", and refers to Frieden, et al. col. 8, lines

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25-30 (see the Office Action discussion regarding claim 78). However, this passage of Frieden, et al. merely describes a "software tool" that "facilitates importing or exporting large blocks of tag data to and from a tag interrogator." Contrary to the Examiner's assertion, Frieden, et al. makes no mention of the specific form and manner in which the information from the database is obtained, namely by creating at least one file containing information from an existing database, as recited in Applicant's amended claims 72 and 105.

There are several advantages to creating a file containing information from an existing database, as recited in claims 72 and 105. Some of these advantages are described in the specification at page 2, line 30 through page 3, line 8, which state as follows:

The present invention, which typically uses lists or files created from an existing database, has several advantages over systems that attempt to provide direct access to an existing database. First, direct access systems require detailed knowledge of the structure of the existing database and how to create a connection to that database. Because the structures may differ based on the database, as described above, direct connections may be difficult to obtain. Second, direct access is relatively slow compared to file access (as used herein), because the existing database is generally on a different computer and requested data has to be separated from unrequested data within that database. Extraction into a file provides faster access than by direct query. Third, some existing databases may not support standard access, such as SQL access, but essentially all existing databases should be able to provide some kind of reporting features for generating list files.

In order to support an anticipation rejection under 35 U.S.C. 102(e), it is well established that a prior art reference must disclose each and every element of a claim. This well-known rule of law is commonly referred to as the "all-elements rule."¹ If a prior art reference fails to disclose any element of a claim, then rejection under 35 U.S.C. 102(e) is improper.²

¹ See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (CAFC 1986) ("it is axiomatic that for prior art to anticipate under 102 it has to meet every element of the claimed invention").

² *Id.* See also *Lewmar Marine, Inc. v. Barlett, Inc.* 827 F.2d 744, 3 USPQ2d 1766 (CAFC 1987); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (CAFC 1990); *C.R. Bard, Inc. v. MP Systems, Inc.*, 157 F.3d 1340, 48 USPQ2d 1225 (CAFC 1998); *Oney v. Railiff*, 182 F.3d 893, 51 USPQ2d 1697 (CAFC 1999); *Apple Computer, Inc. v. Articulate Systems, Inc.*, 234 F.3d 14, 57 USPQ2d 1057 (CAFC 2000).

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Frieden, et al. fails to disclose each and every limitation set forth in independent claims 1 and 105. For at least these reasons, the Examiner has failed to establish a prima facie case for anticipation of Applicant's claims 72 and 105 under 35 U.S.C. 102(e). In addition, because claims 74-77 and 79-104 depend upon claim 72 and contain all of the limitations thereof, and because claims 106-113 depend upon claim 105 and contain all of the limitations thereof, the Examiner has similarly failed to establish a prima facie case for anticipation of Applicant's dependent claims 74-104, and 106-113. Withdrawal of the rejection of all pending claims 72, 74-113 is therefore respectfully requested.

CONCLUSION


All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed attorney to discuss this application.

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December 15, 2004

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